



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/434,196	11/04/1999	GURUCHARAN REDDY	A-64077-2/RF	3611

7590 12/18/2001

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
SUITE 3400
FOUR EMBARCADERO CENTER
SAN FRANCISCO, CA 941114187

EXAMINER

SANDALS, WILLIAM O //

ART UNIT	PAPER NUMBER
----------	--------------

1636

DATE MAILED: 12/18/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/434,196

Applicant(s)
Reddy et al.

Examiner
William Sandals

Art Unit
1636



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 26, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 14, 16-26, and 28 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-6, 14, 16-23, 26, and 28 is/are rejected.
- 7) ☒ Claim(s) 2, 24, and 25 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 7
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Art Unit: 1636

DETAILED ACTION

Response to Arguments

1. Arguments set forth in Paper No. 10, filed September 26, 2001 have overcome the rejection of claims 1, 2, 4, 5, 14, 16-19 and 21-26 under 35 USC 102 over Shinohara et al., in the previous office action, and the rejection is withdrawn.
2. Arguments set forth in Paper No. 10, filed September 26, 2001 have overcome the rejection of claims 3, 5, 6 and 23-26 under 35 USC 112, second paragraph, and the rejection is withdrawn
3. Arguments filed in Paper No. 10 regarding the rejection of claims 1, 4, 5, 23 and 26 under 35 USC 102 over Park et al. have been fully considered but they are not persuasive. The response to the arguments is contained in the rejection repeated below.
4. Arguments filed in Paper No. 10 regarding the rejection of claim 20 under 35 USC 112, first paragraph have been fully considered but they are not persuasive. The response to the arguments is contained in the rejection repeated below.
5. Arguments filed in Paper No. 10 regarding the rejection of claims 14, 16-22 and 28 under 35 USC 112, second paragraph have been fully considered but they are not persuasive. The response to the arguments is contained in the rejection repeated below.

Art Unit: 1636

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claim 20 (and all dependent claims 17, 21, 22 and 28) is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 20 recites “homology scanning” at lines 1, 7 and 8. This term is not described in the original claims or specification and as such constitutes new matter. Correction is required. For the purposes of examination, it is assumed that the term “homology scanning” has the same meaning as “binding activity” or “annealing activity” as recited in claims 16 and 17.

Response to Arguments

8. Arguments set forth in Paper No. 10 assert that “homology scanning” is defined at page 25 of the instant specification. No definition has been found at page 25. It is further asserted that “homology scanning” is an art recognized term. No substantiation of this assertion has been entered in proof. The arguments are therefore not found convincing.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 1636

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 14, 16-22 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claims 14, 16-22 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: Step “b)” is recited to screen for “altered activity”. There is no recitation in the step which indicates what the “activity” is or how the previous combining step leads to any activity to be measured.

Response to Arguments

12. Arguments set forth in Paper No. 10 assert that the method steps are clear as written. However, the explanation of the meaning of the steps for each claim provides a new and altered meaning to the claim. Therefore, the arguments themselves provide a significant reasoning for the clarification of the methods as claimed. The arguments are therefore not found convincing.

13. Claim 20 recites the term “homology scanning”. “Homology scanning” is not defined in the specification or claims. Without proper guidance as to the meaning of the term, one of ordinary skill in the art would not know the metes and bounds of the claim.

Art Unit: 1636

Response to Arguments

14. Arguments set forth in Paper No. 10 assert that "homology scanning" is defined at page 25 of the instant specification. No definition has been found at page 25. It is further asserted that "homology scanning" is an art recognized term. No substantiation of this assertion has been entered in proof. The arguments are therefore not found convincing.

Claim Rejections - 35 USC § 102

15. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

16. Claims 1, 4, 5, 23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Park.

Park taught (see especially the introduction) a composition comprising a first single stranded nucleic acid, a second single stranded nucleic acid and a human Rad52 protein from a higher eukaryote where the nucleic acids may be perfectly matched or partially matched.

Response to Arguments

Arguments set forth in Paper No. 10 assert that Park et al. does not teach a specific nucleoprotein complex. This argument is not found convincing, since the Rad52 protein and the nucleic acids in the cell must form a complex where a duplex DNA is separated into separate

Art Unit: 1636

strands, where the strands are complementary to one another, and the protein is at least 90% homologous to amino acids 36-185 of human Rad52. This satisfies all of the limitations of the claims. Other arguments are not directed to the limitations of the claims and as such do not apply. Therefore, the arguments are not found convincing and the rejection stands.

Allowable Subject Matter

17. Claims 2, 24 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

18. Certain papers related to this application are ***welcomed*** to be submitted to Art Unit 1636 by facsimile transmission. The FAX numbers are (703) 308-4242 and 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by the applicant or applicant's representative, and the FAX receipt from your FAX machine is proof of delivery. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Art Unit: 1636

Any inquiry concerning this communication or earlier communications should be directed to Dr. William Sandals whose telephone number is (703) 305-1982. The examiner normally can be reached Monday through Friday from 8:30 AM to 5:00 PM, EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott can be reached at (703) 308-4003.

Any inquiry of a general nature or relating to the status of this application should be directed to the Zeta Adams, whose telephone number is (703) 305-3291.

William Sandals, Ph.D.

Examiner

December 17, 2001


TERRY MCKELVEY
PRIMARY EXAMINER